

REMARKS

Claims 1-39 are presented for consideration by the Examiner. The claims have been amended in response to the objections and remarks in the Office Action mailed June 29, 2006, and every ground of rejection has been addressed by this response.

I. OBJECTIONS UNDER 37 CFR 1.75(d)(1) ARE TREATED.

Claims 1, 7-9, 12, 14, 20-22, 25, 27, 33-35 and 38 were objected to by the Office. Applicants have amended these claims consistent with the remarks in the Office Action and such amendments are believed to satisfy the objections raised by the Office.

II. REJECTIONS OF CLAIMS UNDER 35 U.S.C. §101 ARE TREATED.

Claims 1-39 were rejected as being directed to non-statutory subject matter. Applicants respectfully traverse this rejection for the following reason. The present invention produces a useful, concrete and tangible result. The invention comprises inputting data into a computing device which manipulates the data into a three dimensional image of an artificial fingernail. The three dimensional image is a useful, concrete and tangible result that can be displayed via the computing device's display or translated into a printed image. As a consequence, this invention is directed to patentable subject matter under Section 101.

Further, applicants have amended the claims to more succinctly claim what the method, process or computer program does to achieve a practical application with a useful, concrete and tangible result. Thus, as a consequence, applicants submit that the invention now claimed is directed to statutory subject matter.

III. REJECTIONS OF CLAIMS UNDER 35 U.S.C. §102(a) ARE TREATED

The Office Action raised an issue with respect to claims 1-3, 5, 6, 8-16, 18, 19, 21-29, 31, 32 and 34-39 under 35 U.S.C. § 102(a) as being anticipated by Yogo et al. (U.S. Patent Application Publication No. 2004/0143359, hereinafter referred to as the "Yogo reference"). Applicants respectfully traverse this rejection on the following two bases, namely: (i) The Yogo reference is not prior art to this application; and (ii) even if the Yogo reference is prior art, it teaches a different process than claimed by applicants.

First, for 35 U.S.C. 102(a) to apply, the reference must have a publication date earlier in time than the effective filing date of the current application, and the reference **must not be applicants' own work**. MPEP § 706.02(a). In this case, the Yogo reference is not prior art because it is applicants' own work, despite the fact that applicants are not named as the inventors in the Yogo reference.

The Yogo reference is invalid because it does not name all of the true inventors. Most of the elements claimed and disclosed in the Yogo patent reference were actually invented by or contributed by Scott L. Nielson and Craig P. Gifford, the inventors of the invention claimed in the current patent application. Because those two inventors were not named in the Yogo reference, the Yogo patent reference is not prior art to this application and further it is invalid. Accordingly, applicants submit that the Yogo reference is not prior art as that term is defined under 35 U.S.C. §102(a).

Secondly, even if the Yogo reference can be considered prior art, the reference teaches a three step process comprising: (1) Making a three dimensional digital image of a fingernail; (2) Creating a three dimensional artificial nail image based on the three dimensional fingernail image; and, (3) Milling an artificial fingernail based on the three dimensional artificial nail image.

In contrast, the present application does not involve these three steps. Rather, the present application claims a variant of the second step disclosed in the Yogo reference in that the present application presents specific detail regarding the manner in which the data is manipulated by the computer program to generate the three dimensional artificial fingernail image. Accordingly, the Yogo reference teaches a different process than

claimed by applicants in this application and as such the Yogo reference does not anticipate the claims of the present application.

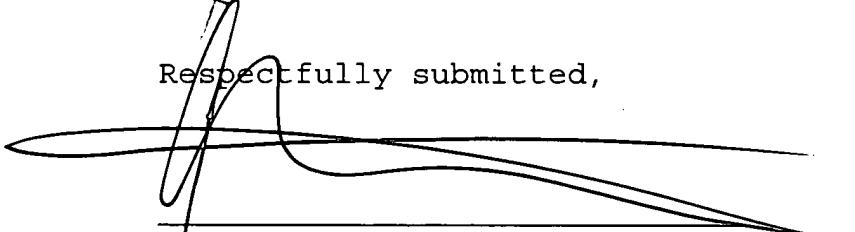
IV. CONCLUSION AND AUTHORIZATION OF DEPOSIT ACCOUNT

Applicants express appreciation for the guidance provided by the examiner in the Office Action. In view of the foregoing, applicant believes that claims 1-39 are all allowable and the same is respectfully requested. If any impediment to the allowance of these claims remains after entry of this Amendment, and such impediment could be alleviated during a telephone interview, the Examiner is invited to initiate the same.

The Commissioner is hereby authorized to charge any additional fee or to credit any overpayment in connection with this Amendment to Deposit Account No. 50-0836.

DATED this 31 day of December, 2007.

Respectfully submitted,

  
Grant Clayton  
Attorney Registration No. 32,462  
Attorney for Applicant

Clayton, Howarth & Cannon, P.C.  
P.O. Box 1909  
Sandy, UT 84091  
Telephone: (801) 255-5335  
Facsimile: (801) 255-5338